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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,673	05/15/2001	Toshimitu Kimura	040679/1263	1146

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EXAMINER

WILKINS III, HARRY D

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/854,673

Applicant(s)

KIMURA ET AL.

Examiner

Harry D Wilkins, III

Art Unit

1742

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-25.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: though the spheroidizing processing limitations have appeared in a method claim (original claim 6), such limitations had not previously appeared in a product claim. Thus, adding such limitations to the product claims (1, 4 and 20) would require further consideration.

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons stated in the final rejection. In addition, the Examiner asserts that there is still some uncertainty to the actual scope of claim 20, in that it is unclear what the actual range of Si is. Regarding the argument about unexpected results, the comparison examples that compare low Cr and Mo values in the specification (Table 2) are farther from the present invention than the closest prior art. In other words, Applicant has not compared the closest prior art. Applicant has compared (Example 4) an alloy with 0.3 wt% Cr+Mo, whereas, if the disclosure of Eguchi et al were limited to its preferred embodiment, the prior art teaches 2.5 wt% Cr+Mo, which is much closer to the present invention than the comparison example provided. Thus, no unexpected results over the prior art have been shown. Though Applicant argues to the contrary, the Examiner maintains his position that the disclosure of the prior art should not be construed as being limited only to the preferred embodiments. In response to Applicant's argument that the rejection is an "obvious to try" rejection, the ASM Handbook article provides (see middle column of page 46) a clear teaching as to how to achieve spheroidizing, and the variables necessary to achieve spheroidizing (temperature and cooling rate, per third example). Thus, the prior art does teach which parameters are critical in the spheroidizing operation. In addition, the ASM Handbook provides (see page 47, middle and right cols.) that low-carbon steels produce "gummy" steels when spheroidized due to a low hardness, but that when carbon or alloy content is increased, the hardness increases. Thus, when the alloy content, such as Cr and Mo, was increased, one of ordinary skill in the art would have expected the ability of the low-carbon steels to be machined after spheroidizing to have increased because of the increased hardness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry Wilkins, III whose telephone number is (703) 305-9927. The examiner can normally be reached on Monday-Thursday 6:00 am -4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application of proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

March 19, 2003  
hdw

Harry D. Wilkins, III  
Examiner  
Art Unit 1742

ROY KING  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700